REMARKS

Thorough examination of the application is sincerely appreciated.

Applicant wishes to thank the Examiner for indicating allowability of claims 11 and 13-15.

Claim 11 is amended to remove those features that are not necessary to distinguish over the prior art of record. Applicant regrets any inconvenience to the examiner.

1) According to the Final Office Action, claims 6, 7 and 17 were rejected under 35 USC 103(a) as being obvious over US Patent 5,353,312 (hereinafter "Cupo"). 2) Further according to the Final Office Action, claims 8 and 19 were rejected under 35 USC 103(a) as being obvious over Cupo in view of alleged figure 1 admitted prior art. 3) Still further to the Final Office Action, claims 4, 5, 9 and 10 were rejected under 35 USC 103(a) as being obvious over US Patent 5,703,905 (hereinafter "Langberg") in view of the alleged admitted prior art and further in view of "Digital Communications Fundamentals and Applications" (hereinafter "Sklar").

In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a prima facie case of obviousness in accordance with the established cases and statutory law.

1) On page 4 of the Final Office Action, the examiner alleges that Cupo teaches "a timing recovery circuit 123 for generating a timing recovery control signal based upon the equalized feedback signals via leads 124 and 125." For such disclosure, the examiner relies on Cupo's col. 4, lines 10-30. Applicant's representative has carefully reviewed the Cupo patent and failed to find such a disclosure in the patent, contrary to the examiner's remarks. Cupo does not teach or suggest Applicant's feature of "N forward equalizers, each generating and outputting an Nth equalized feedback signal based on the Nth symbol stream at the second sampling rate,

respectively," as recited in claim 7. Cupo's elements 124 and 125 are not output signals, not generated, and not equalized feedback signals: such a disclosure is absent in Cupo. As clearly shown in Cupo's Fig. 1, elements 124 and 125 are not outputs: they are leads that couple equalizers 106, 107 to timing recovery circuit 123 to account for the delay being a function of the equalized coefficients. Hence, Cupo's 124 and 125 are not signals, not output signals, and not output equalized feedback signals, in contrast to Applicant's claimed feature.

Perhaps, the examiner believes otherwise. If this is the case, he is respectfully requested 1) to specifically point out where a disclosure on such equivalence between equalizer delays and an Nth equalized feedback signal can be found in Cupo; 2) to provide an affidavit stating facts within his personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Cupo can't be supported by the record.

On page 5 of the Final Office Action, the examiner alleges that "as suggested by Cupo et al. disclosure, because the timing adjustment signals are a function of the delay introduced by each equalizer, one of ordinary skill in the art at the time the invention was made would have recognized that the delay signal can be a combination of the equalizer outputs taking into account delay introduced by each equalizer."

Perhaps, the examiner relied on personal knowledge of the facts or those of a skilled artisan in the statement that "one of ordinary skill in the art ..." on page 5 of the Office Action. If this is the case, then "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 1371. The MPEP provides guidelines for relying on official notice and personal knowledge, which the Examiner did not follow in this case:

> The rationale supporting an obviousness rejection may be based on common knowledge in the art of "well-known" prior art. The

> examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art ...
>
> When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

See MPEP §2144.03. If the rejection is maintained, it is respectfully requested that the examiner provide an affidavit stating facts within his personal knowledge or an affidavit by a skilled artisan.

It is respectfully submitted that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Analyzing the reference according to the above roadmap, first the examiner offered an unsupported, conclusory remark pertaining to a skilled artisan. It is not clear what the basis was for such an assertion. There is absolutely no motivation or suggestion to take Cupo's individual equalizer delays and transform them into Applicant's feature of "the TR control signal based upon a combination of the N equalized feedback signals", except on the basis of the

impermissible hindsight and knowledge gleaned from Applicants' invention. Such a practice is prohibited by the applicable law and cannot possibly be sanctioned by the USPTO.

Second, the examiner failed to provide an affidavit for Official Notice or a level of skilled artisan.

Third, Cupo does not teach all of the Applicant's features as recited in claim 7. See, for example, the above discussion regarding an N equalized feedback signal. As argued above, the Applicant's features are not taught or suggested in the prior art reference.

Therefore, the cited reference fails to render obvious the claimed invention, because the above-identified criteria are not met. The claimed invention, according to claim 7, is thus distinguishable over Cupo.

Analysis of independent claim 17 is analogous to the one of claim 7, as presented hereinabove. To avoid repetition, claim 17 will not be discussed in detail with the understanding that it is patentable at least for the same reasons as claim 7. Applicant, therefore, respectfully requests withdrawal of the rejection and allowance of claim 17.

Claim 6 depends from independent claim 7, which has been shown to be allowable over the prior art references. Accordingly, claim 6 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claim 6 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

2) Claims 8 and 19 depend from independent claim 7, which has been shown to be allowable over the prior art reference. It is respectfully submitted that Applicant's Figure 1 is not admitted prior art, as argued in Applicant's previous response of May 8, 2006. If the examiner disagrees, he is respectfully requested to provide an affidavit stating facts within his

personal knowledge or to provide a prior art reference stating the same.

But even if, for the sake of argument, the examiner is able to rely on Applicant's Figure 1, such a disclosure is not relied upon in the Final Office Action to teach or suggest Applicant's features in independent claim 7. Hence, the deficiencies in Cupo are not cured. Accordingly, claims 8 and 19 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 8 and 19 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

3) With respect to claims 4, 5, 9 and 10, the examiner's rejection based on Langberg is not understood, and clarification is respectfully requested. Claims 4, 5, 9 and 10 all depend from independent claim 7, which has been rejected over Cupo. It is not clear as to how Langberg can be a primary reference in the rejection of dependent claims, while the independent claim is rejected over Cupo.

In any event, it is respectfully submitted that neither Langberg nor Sklar cure the deficiencies in Cupo. For this reason, claims 4, 5, 9 and 10 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 4, 5, 9 and 10 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

In view of the above, it is respectfully submitted that Cupo, Langberg and Sklar, whether alone or in combination, do not anticipate or render obvious the present invention.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited. However, if for any reason this application is not considered to be in

condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the number listed below prior to issuing a further Action.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

By _____
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